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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 08/776,786 | 05/01/97 | BARKATS | M ST94065-US |

HM22/0627
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| EXAMINER | |
|---|---|
| PRIEBE,S | |
| ART UNIT | PAPER NUMBER |
| 1632 | 23 |

DATE MAILED: 06/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

| Office Action Summary | Application No. 08/776,786 | Applicant(s) Barkats et al. |
|---|---|---|
| | Examiner Scott D. Priebe, Ph.D. | Group Art Unit 1632 |

☒ Responsive to communication(s) filed on *Apr 7, 2000*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) *27, 34-36, 38, 40, 41, and 48-50* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *27, 34-36, 38, 40, 41, and 48-50* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---*

## DETAILED ACTION

### *Continued Prosecution Application*

The request filed on 4/7/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/776,786 is acceptable and a CPA has been established. The amendment filed 10/8/99 had been entered, as indicated in the Advisory action filed 10/19/99. Claims 28-33, 37, 44-47 and 51-55 had been cancelled; claims 27, 34, 36, 38, 40, 41 and 48 hade been amended; and claims 27, 34-36, 38, 40, 41 and 48-50 are pending. No amendments were filed with the request for a CPA. An action on the CPA follows.

### *Information Disclosure Statement*

~ Receipt of the information disclosure statement filed 6/16/00 (Paper No. 22) is acknowledged. The paper has been evaluated under MPEP 1448, 2010 and 2012. No further action concerning the disclosure statement is deemed warranted.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 27, 34-36, 38, 41, and 48-50 remain rejected under 35 U.S.C. 102(b)/103(a) as being unpatentable over Kahn et al. in view of Mullenbach et al. (UCLA Symp. Mol. Cell. Biol., New Ser., v. 82, pp. 313-326 (1988) for the reasons of record set forth in the Office action of January 1, 1998.

Claims 27, 34-36, 40, 41 and 48-50 remain rejected under 35 U.S.C. 102(e)/103(a) as being unpatentable over McClelland et al., U.S. 5, 543,328 in view of Mullenbach et al. UCLA Symp. Mol. Cell. Biol., New Ser., v. 82, pp. 313-326 (1988) for the reasons of record set forth in the Office action of January 1, 1998.

Claims 36, 38 and 50 remain rejected under 35 U.S.C. 102(e)/103(a) as being unpatentable over McClelland et al., U.S. 5, 543,328 and Mullenbach et al. (UCLA Symp. Mol. Cell. Biol., New Ser., v. 82, pp. 313-326 (1988)) as applied to claims 27, 34-36, 40, 41 and 48-50 above, and further in view of Akli et al. (1993) Nat. Genet. **3**: 224-228 for the reasons of record set forth in the Office action of January 1, 1998.

Applicant's arguments filed 4/7/00 have been fully considered but they are not persuasive. The central issue is whether it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the art recognized vectors taught by either Kahn et al. or McClelland et al. for their art recognized purpose to express, in an appropriate host cell, a nucleic acid that encodes an art recognized protein of interest. The arguments presented do not address this issue. The present fact situation is not analogous to the fact situations in *In re Dembiczak*, 50 USPQ2d 1614 (CA FC 1999); *In re Deuel*, 34 USPQ2d 1210 (CA FC 1995); or *In re Vaeck*, 20 USPQ2d 1438 (CA FC 1991). Both *In re Dembiczak* and *In re Vaeck* involve situations where the inventions taught in the prior art were being used, as posited in the rejections, in ways that had not been suggested by the prior art. For example, in *In re Vaeck*, the chimeric gene of Dzelzkalns was designed to characterize promoters present in the chimeric gene, not to produce proteins encoded by the chimeric gene, as was the thrust of the invention being claimed; there was no motivation or suggestion to use an insecticidal protein as a reporter in place of CAT. In *In re Dembiczak*, there was no suggestion in the prior art cited in the rejection to decorate

trash bags in any way, let alone to decorate them as jack-o-lanterns as claimed. In the instant case, the adenoviral vectors would have been used for their designed purpose, to express a desired protein. *In re Deuel* dealt with the issue of whether disclosure of a genus could anticipate a previously unknown species. That is not the case here, where the combination claimed is made up of parts (or subcombinations) previously known in the art.

***Conclusion***

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the

statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasemine Chambers, can be reached on (703) 308-2035.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Scott D. Priebe

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Art Unit 1632